

REMARKS

In the subject Office Action, the abstract was objected to because it contains the word “comprises”. Applicants have amended the abstract in a manner believed to overcome the objection. Accordingly, applicants respectfully request withdrawal of the objection to the abstract.

Claim 18 was objected to because the claim did not end with a period. Applicants with this Reply have amended claim 18 to correct this typographical error. Therefore, applicants respectfully request withdrawal of the objection to claim 18.

Claims 1-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lal et al. (U.S. Patent No. 5,520,661) in view of Weilbacher et al. (U.S. Patent No. 5,360,418) and further in view of Sharp et al. (U.S. Patent No. 6,394,979) and Enerson (U.S. Patent No. 6,988,510).

It was stated in the subject Office Action that Lal et al. disclose the invention substantially as claimed except for the at least top, bottom, or diaphragm holder having parylene, the medium static turning torque with the set forth ranges, and the parylene having a thickness of about 0.10 microns to about 3.0 microns. While Lal et al. may disclose the features as stated by the Office Action, applicants submit that even if it is proper to combine Weilbacher et al., Sharp et al., and Enerson, which it is not since Weilbacher et al. and Sharp et al. are non-analogous art and there is no motivation to combine all the references, the combination still fails to teach or suggest the features of the present claims.

First, Weilbacher et al. and Sharp et al. are not analogous prior art. Weilbacher et al. disclose a connector for catheters and Sharp et al. disclose a cannula. Analogous art

requires that a reference either be in the field of the applicant's endeavor or be reasonably pertinent to the problem with which the inventor was concerned. The field of endeavor of the present application is medical fluid flow regulators and the problem of concern is preventing the undesirable effects of silicone lubricants while retaining or preferably improving the performance and turning torque of the regulator. Neither Weilbacher et al. nor Sharp et al. meet either of these criterion. Moreover, no reasons have been provided showing how and why one of ordinary skill in the art would have been motivated to select the Weilbacher et al., Sharp et al. and Enerson references and to combine them with the Lal et al. reference to render the claimed invention obvious. Therefore, applicants submit that these references should not have been combined with Lal and respectfully request reconsideration and withdrawal of the rejection of all the claims.

Enerson discloses a disc check valve. While disc check valves may be related to medical fluid flow regulators, Enerson strictly teaches lubricating the disc with parylene in contrast to the claimed subject matter which recites a device for regulating the flow of intravenous fluid having a top or bottom of the housing or the diaphragm holder including parylene. Enerson provides no teaching, suggestion or motivation alone or in combination with Lal et al. to provide a device for regulating the flow of intravenous fluid having a top and bottom of a housing and either the top or the bottom comprising parylene as recited in claim 1 along with other features or to provide a device for regulating the flow of intravenous fluid having a top and bottom of a housing, a diaphragm holder disposed in the housing, and at least one of the top or bottom or the diaphragm holder comprising parylene as recited in claim 10 along with other features. Indeed, Enerson teaches away from lubricating the top, bottom or diaphragm holder since

applying lubrication to the disc check valve would appear to render any need to lubricate any part in contact with the disc superfluous. Accordingly, applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 10.

Since claims 2-9 and 11-18 depend from claims 1 and 10, respectively these claims should be allowable for the same reasons. Additionally, these dependent claims are patentably distinct and recite features not taught or suggested by the prior art alone or in combination. The Office Action indicates that the medium static torque and parylene thickness are merely preferable. Applicants submit that these features are positively recited in some of the dependent claims and are not matters of design choice. It is only through hindsight reasoning that the features of the claims are arguably deemed matters of design choice. Therefore, applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-9 and 11-18.

Furthermore, even if the disclosures of Weilbacher et al., Sharp et al. and Enerson are properly combined with Lal et al., which we submit they should not, this combination still does not teach or suggest the claimed subject matter. Weilbacher et al. discloses using a lubricant on a catheter connector to ease the catheter and suction source onto the ends of the connector. Sharp et al. discloses coating the piercing section of the cannula to ease penetration. Enerson discloses lubricating a disc check valve. The combination of these references would not have taught or suggested to one of ordinary skill at the filing of the application a device for regulating the flow of intravenous fluid having at least one of a top and bottom of a housing and a diaphragm holder including parylene. Therefore, applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 10.

Since claims 2-9 and 11-18 depend from claims 1 and 10 respectively these claims should be allowable for the same reasons. Additionally, these dependent claims are patentably distinct and recite features not taught or suggested by the prior art alone or in combination. The Office Action indicates that the medium static torque and parylene thickness are as merely preferable. Applicants submit that these features are positively recited in some of the dependent claims and are not matters of design choice. It is only through hindsight reasoning that the features of the claims are arguably deemed matters of design choice. Therefore, applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-9 and 11-18.

For all the foregoing reasons, Applicants respectfully request withdrawal of the objections to the abstract and claim 18 and reconsideration and withdrawal of the rejections of claims 1-18. A Notice of Allowance is respectfully requested.

It is believed that no fees are due with this reply. However, if a fee should be required, the Commissioner is authorized to charge our Deposit Account No. 50/1039.

Respectfully submitted,

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